UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,959	12/27/2001	Michael A. Epstein	US010711	8573

24737 7590 02/17/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
SCHUBERT, KEVIN R	
ART UNIT	**PAPER NUMBER**
2137	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/033,959	EPSTEIN ET AL.	
	Examiner	Art Unit	
	Kevin Schubert	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 22-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 22-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-13 and 22-28 have been considered. Examiner maintains the rejections presented in the previous action. A response to arguments section concludes the action.

Specification

The specification is objected to in accordance with the 35 U.S.C. 112 first paragraph enablement rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 22-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Specification does not provide adequate detail as to how the invention works. More specifically, the Specification does not provide adequate detail in explaining how the sequences presented on the screen are invisible to someone viewing the film in a theater and visible to someone viewing a copy of the film. Without presentation of adequate detail explaining how the invention accomplishes this critical feature, one of ordinary skill in the art would not be able to make and/or use the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2,5-8,10,13,22-23,25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaum, U.S. Patent No. 5,959,717.

As per claims 1 and 22, the applicant describes a method for preventing copying of video images projected onto a screen comprising the following limitations which are met by Chaum:

a) selecting a scanning sequence from a plurality of predetermined scanning sequences (Col 7, lines 31-64);

b) projecting a plurality of colored light beams onto the screen concurrently with the images, in accordance with the selected scanning sequence, for a finite period of time (Col 7, lines 31-64);

c) repeating steps a) and b) at least one time (Col 7, lines 31-64).

As per claims 2 and 5, the applicant describes the method of claim 1, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein at least one of the scanning sequences in step a) includes scrolling the plurality of colored light beams (Col 8, lines 51-54).

As per claim 6, the applicant describes the method of claim 1, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein at least one of the scanning sequences in step a) includes flashing the plurality of colored light beams (Col 7, lines 31-64).

As per claims 7,8, and 25, the applicant describes the method of claims 1 and 22, which are met by Chaum, with the following limitation which is also met by Chaum:

Wherein the step c) is performed when a predetermined event occurs (Col 7, lines 31-64).

As per claims 10 and 23, the applicant describes the method of claims 1 and 22, which are met by Chaum, with the following limitation which is also met by Chaum:

Wherein the selecting step is performed randomly (Col 7, lines 55-58).

As per claim 13, the applicant describes the method of claim 8, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein the predetermined event includes at least one of a predetermined level of a known color, a known image, a known period of time, and a mark selectively placed in the images (Col 6, lines 59-63).

As per claim 28, the applicant describes the apparatus of claim 22, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein the light source includes a plurality of light-emitting diodes, wherein at least two of the light-emitting diodes produce two different colors (Col 7, lines 31-64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum.

As per claims 3 and 4, the applicant describes the method of claim 2, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein the scrolling includes horizontal scrolling (Col 8, lines 51-54);

Chaum discloses all the limitations of claim 2. Chaum also discloses the use of diagonal scrolling. However, Chaum does not disclose horizontal or vertical scrolling. The examiner takes official notice that it is well-known in the art that data may be scrolled in a horizontal or vertical fashion. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to scroll data in a horizontal or vertical fashion because doing so is another means to effectively present an alert to a user.

Claims 9,11-12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum in view of Munich, U.S. Patent No. 5,182,771.

As per claims 9,11-12, and 24, the applicant describes the method of claims 8,1, and 22, which are met by Chaum, with the following limitation which is met by Munich:

Wherein the predetermined event includes an aspect of the content in the image, the content of the image determining when a mark is to be placed in the images (Munich: Col 11, lines 3-15; Col 12, lines 60-68);

Chaum discloses all the limitations of claims 8 and 22. However, Chaum does not disclose that image content can be used to determine when a mark or alert is to be placed in the images. Munich discloses a similar copy protection system in which image content such as scene changes are used to trigger a security event. It would have been obvious to one or ordinary skill in the art at the time the invention was filed to combine the ideas of Munich with those of Chaum because presenting an alert at notable times during a movie, such as scene changes, is another way to annoy a user of an illegally copied movie.

Claims 9,11-12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum in view of Epstein, U.S. Patent No. 6,529,600.

As per claims 9,11-12, and 24, the applicant describes the method of claims 8 and 1, which are met by Chaum, with the following limitation which is met by Epstein:

Wherein the predetermined event includes an aspect of the content in the image, the content of the image determining when a mark is to be placed in the images (Epstein: Col 2, lines 55-60);

Chaum discloses all the limitations of claims 8 and 22. However, Chaum does not disclose that image content can be used to determine when a mark or alert is to be placed in the images. Epstein discloses a similar copy protection system in which image content is used to trigger a security event. It would have been obvious to one or ordinary skill in the art at the time the invention was filed to combine the ideas of Epstein with those of Chaum because presenting an alert at notable times during a movie, such as during image content changes and/or scene changes, is another way to annoy a user of an illegally copied movie.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum in view of Mead, U.S. Patent No. 5,680,454.

As per claims 26-27, the applicant describes the apparatus of claim 22, which is met by Chaum, with the following limitation which is met by Mead:

Wherein the processor further causes the light source to project the colored light beams onto the screen in accordance with a randomly selected scanning rate, for a finite period of time (Mead: Col 1, line 44 to Col 2, line 6).

Chaum discloses all the limitations of claim 22. However, Chaum does not disclose the idea of modifying the scanning rate. Mead discloses a similar copy prevention system in which the scanning rate is randomly altered. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Mead with those of Chaum for at least the following two reasons: first modifying the scanning rate prevents a further means to annoy a user watching an illegally copied movie (for example, the alert may flicker) and second randomly modifying the scanning rate makes it more

difficult for a person making an unauthorized copy of a movie to "break" the system and make a viewable copy of the movie.

Response to Arguments

Applicant's arguments filed 1/9/06 with respect to the rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement have been fully considered but they are not persuasive.

As properly noted by applicant, the test for enablement is whether subject matter is described in the Specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. Examiner has rejected the claims in the previous action based on applicant's method of preventing copying of video images not complying with the enablement requirement. More specifically, Examiner has stated the following in the previous action (mailed 8/9/05):

> "The Specification does not provide adequate detail in explaining how the sequences presented on the screen are invisible to someone viewing the film in a theater and visible to someone viewing a copy of the film. Without presentation of adequate detail explaining how the invention accomplishes this critical feature, one of ordinary skill in the art would not be able to make and/or use the invention" (page 2, line 24 to page 3, line 2).

Applicant contends that the Specification discloses presenting sequences in such a way that they are invisible to someone viewing a video screen and visible to someone viewing a copy of the film. Applicant further contends that the Specification also discloses that images are typically exposed at a nominal frame rate of 24 frames per second and that video recording devices typically record images at 30 frames per second. From the above, applicant concludes that one of ordinary skill in the art would have been able to make and/or use the invention.

Examiner respectfully disagrees. Examiner was aware of the above when the enablement requirement was applied. Examiner maintains that adequate detail has not been provided which enables the method of presenting sequences such that they are invisible to someone viewing a video screen and visible to someone viewing a copy of the film. Applicant's argument that the method is achieved via presentation of images in particular fashion does not enable one of ordinary skill in the art to make and/or

use the invention. It appears that applicant may be presenting the idea that the fashion the images are presented is related to frame rate. However, such a disclosure is akin to the presentation of a vague and general idea lacking adequate detail for one of ordinary skill in the art to make and/or use the invention. Accordingly, Examiner respectfully submits that the enablement requirement has not been satisfied.

Applicant's arguments with respect to claims 1-13,22, and 25-28 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without **specifically pointing out how the language of the claims patentably distinguishes them from the references**. Examiner respectfully submits that a presentation of the claims followed by a general allegation that the claimed invention is patentably distinct over the referenced prior art does not comply with 37 CFR 1.111(b).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER